

REMARKS

This Amendment is responsive to the Final Office Action dated June 7, 2006. Claims 21-45 were pending in the application. In the Office Action, claims 21-45 were rejected. In this Amendment, claims 21 and 41 were amended and claim 42 was cancelled. Claims 21-41 and 43-45 remain for consideration.

Applicant submits that claims 21-41 and 43-45 are in condition for allowance and requests withdrawal of the rejections.

§ 103 Rejections

Claims 21-22, 25-34 and 36-45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato (USPN 5,950,178) in view of Tcharnyi (CA 2,343,448).

Claims 23 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato (USPN 5,950,178) in view of Tcharnyi (CA 2,343,448) as applied to claim 21 above, and further in view of PTO 892 reference V.

Claims 23 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borgato (USPN 5,950,178) in view of Tcharnyi (CA 2,343,448) as applied to claim 21 above, and further in view of PTO 892 reference U.

Upon Applicant's review, Applicant believes that Examiner has unsuccessfully used the prior art references to establish a prima facie case of obviousness.

In order to establish a prima facie case of obviousness, Examiner has to show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143.

Here, Examiner relies on Borgato for providing a selection of rough stones to a customer and allowing the customer to choose a specific rough stone from the selection of rough stones. The method of selecting and cutting stones as taught in Borgato is how diamonds have been sold for centuries. The novel feature of Borgato is the data processing system in which data on specific sales and gemstone characteristics are stored. Borgato does not contemplate changing the method of selling diamonds but merely changing the method of storing information based on normal diamond sales.

Further, Examiner admits that Borgato does not teach “cutting the specific stone into at least two cut stones, selling the cut stones to the customer, allowing the customer to present the cut stones to at least two recipients, whereby the customer and the recipients have a specific sentimental relationship. providing rough stones and presenting the multiple rough stones to customers.” As mentioned above, Borgato does not give one skilled in the art the motivation to modify the old-aged method of selling diamonds.

To unsuccessfully overcome the deficiencies of Borgato, Examiner relies upon Tcharnyi. Tcharnyi teaches manufacturing and marketing sets of loose polished gemstones that are cut from the same rough gemstone and allowing the consumer to present these sets to a recipient. Tcharnyi, however, merely teaches selling sets of polished gemstones to a consumer and never allows the consumer to see the rough stone. The consumer must rely on the seller as to the source of the stones.

The method of the present invention can be differentiated from the method in Tcharnyi because the present invention allows the customer to take a more proactive roll in the purchasing process. That is, the customer is allowed to choose a particular rough stone and follow that particular stone through the diamond cutting process. The customer gets to

see the stone before and after the cutting thereby adding more emotional value to the stone.

Furthermore, there is no motivation in either Borgato or Tcharnyi to combine these references. That is, Borgato teaches the normal way in which diamonds are bought and sold each day. Borgato does not teach or suggest deviating from this well-known procedure. And Tcharnyi teaches selling sets of polished stones. The consumer is told they come from the same rough stone but the client is not involved in any way in which rough stones are chosen. There is no teaching in Tcharnyi to allow a customer to choose the rough stone to be cut. Thus, one skilled in the art of selling gemstones would not have the motivation to combine these references.

But in order to expedite the prosecution of the present invention, Applicant has amended claims 21 and 41 and cancelled claim 42. These newly amended claims are now clearly not obvious over Borgato and Tcharnyi.

And since Borgato and Tcharnyi -- taken either alone or in combination -- do not teach, suggest or motivate claims 21 and 41 of Applicant's invention, the §103 rejections should be withdraw.

Claims 22-40 depend on claim 21. Since claim 21 is believed to be patentable over Borgato and Tcharnyi, claims 22-40 are believed to be patentable over Borgato and Tcharnyi on the basis of their dependency on claim 21.

Claims 43-45 depend on claim 41. Since claim 41 is believed to be patentable over Borgato and Tcharnyi, claims 43-45 are believed to be patentable over Borgato and Tcharnyi on the basis of their dependency on claim 41.

CONCLUSION

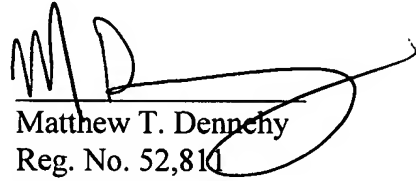
Applicant respectfully submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

If any issues remain, or if the Examiner has any further suggestions, he/she is invited to call the undersigned at the telephone number provided below.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 06-0515.

Respectfully submitted,
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